

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on October 26, 2004. The application has been carefully reviewed in light of the Office action and the interview, and these remarks generated in response thereto.

Claims 1-9 and 11-18 remain in this application. Claim 10 has been canceled.

First, as was discussed at the personal interview, applicant believes that the Examiner has improperly made the rejection final. New grounds have been cited for the rejection of claims 1 and 5. The Examiner states that applicants prior amendment necessitated the new grounds of rejection. This is not reasonable. Applicant merely amended claims 1 and 5 to be more grammatically correct. No limitations were added or removed, and the amendments have no substantive effect on the meaning of the claims. Thus, the amendments could not have necessitated the new grounds for rejection. The Examiner agreed at the personal interview to consider withdrawing the finality of the last action.

Claims 1, 3, 5, 7, 9-12, and 14-17 were rejected under 35 U.S.C. §102(b) as being anticipated by Peairs (U.S. 5,717,940). Claims 2, 4, 6, and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Peairs in view of Tsukasa (U.S. 6, 456,738). Claims 13 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Peairs in view of Hahensee *et al.* (U.S. 6,067,554). For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites an image display method for displaying “description data including predefined attributes each having text information and image information as an attribute value described in a predetermined description format” including a step of “*extracting* said attribute values *from* the description data” and a step of “*listing* the *extracted attribute values*” (emphasis added). Claims 5, 9, and 14 recite similar limitations. As discussed at the personal interview, the cited reference does not teach these limitations.

Instead, Peairs teaches a document management and retrieval system using various transformation techniques, including generating *icons* based on the original documents (which may be in electronic format or scanned into the system). See Summary of the

Invention. However, there is no suggestion that any “attribute” values (including textual information) are *extracted* from the source documents as recited in the claims.

As was discussed at the personal interview, the reference merely teaches creating graphical icons using symbols to replace textual information and reduced resolution images to replace graphics that are found in a web page. There is no suggestion that attributes are embedded in the original data documents, or that values of such attributes, that contain text, are extracted from the documents. Instead, Peairs merely creates a graphical representation of the page so that a user can recognize the page (see Peairs abstract and specification).

Furthermore, there is no teaching by Peairs that it *lists* the values of any attributes. Instead, as discussed at the personal interview, Peairs merely creates reduced resolution icons from the web pages, and it is the icons that are displayed. Hence Peairs further fails to teach the listing steps of the claims.

In the Office action, the Examiner cites Figure 1, page processor 40 and Figure 2 as teaching the “extracting” step. However, as discussed at the personal interview, nowhere do the cited figures, or the accompanying text, discuss any extraction of attribute values. Nor does the reference teach that the attribute values have “text information and image information” as recited in the claim. Finally, the reference does not teach any use of the attributed information as described in the claims (e.g., for “reading and displaying the image information specified by the selected attribute value” as in claim 1).

The Examiner cited Figure 5 in the Office action as listing attribute values. As discussed at the personal interview, close reading of the reference does not support such an interpretation. Figure 5 is a figure showing the display of icons that are *generated* by the page assembler portion of the page processor (see Fig. 2 and the accompanying text. See also col. 2, lines 25-27). No attribute values are “extracted” from the description data, as specified in claim 1. The icons are not “attributes for specifying the image information” and do not have any “values” to display or list, as required by the claims. Further, they are not used for “reading and displaying the image information specified by the selected attribute value”. Thus, the icons of figure 5 are not analogous to the “attributes” recited by the claims.

Consequently, claims 1, 5, 9, and 14 are patentable over the reference. Claims 2-4, which depend directly or indirectly on claim 1, Claims 4-8, which depend directly or

indirectly on claim 5, claims 10-13, which depend directly or indirectly on claim 9, and claims 15-18, which depend directly or indirectly on claim 14, are all patentable over the reference for at least the same reasons as the parent claims.

Finally, claims 9-18 contain limitations similar to those above, and thus are patentable for reasons similar to those discussed above. Furthermore, these claims also contain additional limitations not taught by the reference. For example, claim 9 recites “displaying a representation of a document on a portable display” which is not taught by the reference. Claim 14 recites “a method of displaying, on a portable display, a web page described by one or more data files” which is also not taught by the reference, and thus claims 9-18 are also patentable over the reference for those reasons as well.

Neither Tsukasa nor Hahensee overcome the Peairs shortcomings identified above. Further, Tsukasa does not teach that for which they were cited. Figure 5, elements A, B, and C of Tsukasa do not teach listing alternative character strings. Instead, the cited elements are related to historical information about the document, and as such are “additional” information, not alternative information.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. A conclusory statement of benefit, such as the one provided by the Examiner in the Office action, is not sufficient to show obviousness.

Accordingly, the rejections for obviousness should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present

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application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34102.

Respectfully submitted,

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